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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,921	04/26/2001	Alan R. Peterson	P1403USC2	3534

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JAMES C. SCHELLER, JR.
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025

EXAMINER

VO, TED T

ART UNIT	PAPER NUMBER
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2191

DATE MAILED: 11-3-05

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/844,921

Applicant(s)

PETERSON ET AL.

Examiner

Ted T. Vo

Art Unit

2191

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/4/02, 10/24/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the preliminary amendment filed on 04/26/2001.

Claims 19-27 are filed and in the claims listing.

Claims 19-27 are pending in the application.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 19, 22-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being respectively unpatentable over claims 1-41 of U. S. Patent No. 6,226,785 B1.

Although the conflicting claims are not identical, they are not patentably distinct from each other because:

As per Claim 19: Claim is conflicting to Claims 1-41 in the US Pat. 6,226,785 B1. For example, see Claim 29 of the U. S. Patent.

As per Claim 22: Claim is conflicting to Claims 1-41 in the US Pat. 6,226,785 B1. For example, see Claim

As per Claim 23: Claim is conflicting to Claims 1-41 in the US Pat. 6,226,785 B1. For example, see Claim 18 of the U. S. Patent.

As per Claim 24: Claim is conflicting to Claims 1-41 in the US Pat. 6,226,785 B1. For example, see the flow of Claim 1, 5, 7, or of 10, 12, 13, 14 of the U. S. Patent.

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As per Claim 25: Claim is conflicting to Claims 1-41 in the US Pat. 6,226,785 B1. For example, see the flow of Claim 1, 5, 8, or of 36, 38, 40 of the U. S. Patent.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 20-21, and 26-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 20-21 and 27 that depend on **non-existed Claims** are indefinite. These Claims cannot be examined.

Claim 26 includes limitations, the action class list arranged to be used during playback of an action to determine an explanation associated with the action class; and accompany the played back action with the determined explanation

The underscored functionality as indicated in the above limitations is unclear. The whole limitation of Claim 26 is unclear. Particularly the claimed term "list arranged to be used" is unclear for its' meaning.

The interpretation to Claim 26 is a data structure, an action class list, stored in a computer-readable media having first and second fields; the data in the second field gives the explanation (according to FIG 5 in the specification).

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. The claim 26 is are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

Analysis of Claim 26: Claim recites,

"A computer-readable medium having stored thereon an action class list comprising a plurality of action class description fields, (This limitation indicates it is a list per se)

each action class description field having a first field containing data which specifies a particular action class (This limitation indicates it is a description of a filed, 'first field' in the list per se)

and

a second field containing data which specifies a generic explanation of the action specified in the corresponding first field, (This limitation indicates it is a description of a filed, 'second field' in the list per se)

the action class list arranged to be used during playback of an action to determine an explanation associated with the action class of the action and to accompany the played back action with the

determined explanation" (This limitation indicates the list is only being "arranged" and accompanied with an explanation in association in playback action – This claimed limitation fails to provide functionality led to a practical application, but the functionality of this limitation is a mere descriptive material similar to the matter of music or literary work. See *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759).

According to the analysis of the claim limitation, Claim 26 thus fails to connect with a practical application, but merely describes a data structure. Typically, in order to support to claim 26, the specification indicates the claimed subject matter of Claim 26 as in FIG 5.

The Claim is a data structure per se and fails to be in the technological or useful arts and thus fails to recite patent eligible subject matters.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by Rangan et al., "Design an On-Demand Multimedia Service", IEEE, Pages: 56-64, 7/1992.

Given the broadest reasonable interpretation of followed claims in light of the specification.

As per Claim 26: Regarding the limitation:

A computer-readable medium having stored thereon an action class list comprising a plurality of action class description fields, each action class description field having a first field containing data which specifies a particular action class and a second field containing data which specifies a generic explanation of the action specified in the corresponding first field, the action class list arranged to be used during playback of an action to determine an explanation associated with the action class of the action and to accompany the played back action with the determined explanation

Rangan disclose the claimed limitation by showing a data structure (Table 1, p.58) that includes a first field and second field of a media unit where the media unit presents a frame for video and sample for audio. Particularly, the second field includes with explanation.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ted T. Vo whose telephone number is (571) 272-3706. The examiner can normally be reached on 8:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y. Zhen can be reached on (571) 272-3708.

The facsimile number for the organization where this application or proceeding is assigned is the Central Facsimile number **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ted T. Vo
Primary Examiner
Art Unit 2191
October 28, 2005